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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,911

06/09/2006

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EXAMINER

MAZUMDAR, SONYA

ART UNIT

PAPER NUMBER

1734

MAIL DATE

DELIVERY MODE

05/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/552,911	Applicant(s) HOFSTE, ROY JOHANNES	
	Examiner Sonya Mazumdar	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the starting material" in line 5. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 9, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Grenier (US 6,025,053).

Grenier teaches wood boards, where pieces of coniferous wood are provided and those pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue, and are further bonded to other joined pieces to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g).

Although a preservative heat treatment is not disclosed by Grenier, it is inherent that undesired parts, or parts with defects, are removed from the pieces initially provided and is further taught by Grenier (column 3, lines 33-38). However, if it is not inherent, it would have been obvious for one having ordinary skill in the art to do so to make a wood board of superior quality uniformly and use for structural purposes.

In the event any differences can be shown for the product of the product-by-process claims 9 and 10, as opposed to the product taught by Grenier, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (CAFC 1985).

“When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is

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appropriate. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their particular nature than when a product is claimed in the conventional fashion.” *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974).

With respect to claims 12 and 13, which draw reference to cancelled claims 4 and 5, respectively, the building structure is considered undefined regarding the specificity of the structure.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of the admitted prior art.

Grenier teaches a method of manufacturing wood boards. Pieces of coniferous wood are provided and after inspecting the fiber density of the wood pieces, pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue. The joined pieces are further bonded to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g)

Grenier fails to specifically teach subjecting wood pieces to a preservative heat treatment as a method to remove undesired portions from the pieces. However, the admitted prior art teaches such heating methods are already known and are conventional in the art (page 1, lines 7-20).

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It would have been obvious to Grenier to use such a method taught by the admitted prior art and would have been motivated to do so as an environmentally safe way to improve physicochemical properties of the wood, such as dimensional stability and durability.

7. Claims 3, 6, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of the admitted prior art, as applied to claims 1 and 2 above, and further in view of Versterlund et al. (US 6,284,090)

The teachings of claims 1 and 2 are as described above.

With respect to claims 3 and 6, Grenier does not teach using a specific glue to join wooden pieces. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces.

With respect to claims 7 and 8, Grenier teaches using an appropriate wood glue to bond pieces of coniferous wood (column 4, lines 9-10 and lines 40-41), but does not teach using a specific type of glue. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces, as is conventional in the art.

8. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of Vesterlund et al. (US 6,284,090)

Grenier teaches wood boards, where pieces of coniferous wood are provided and those pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue, and are further bonded to other joined pieces to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g).

Grenier does not teach using a specific glue to join wooden pieces. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces.

### ***Response to Arguments***

9. Applicant's amendment, see page 2 in the remarks filed March 19, 2007, with respect to the specification, have been fully considered, and the objection has been withdrawn.

10. Applicant's amendments, see page 3 in the remarks, with respect to the rejection of claims 1-3 and 6-8 under 35 USC 112, 2<sup>nd</sup> paragraph, have been fully considered. But

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although the phrase "the starting material" was removed from line 3, the exact phrase is present in line 5, accordingly lacking antecedent basis. Therefore, the rejection is maintained.

11. In light of Applicant's cancellation of claims 12 and 13, see page 4 in the remarks, the rejection of claims 12 and 13 under 35 USC 112, 2<sup>nd</sup> paragraph, has been withdrawn.

12. Applicant's arguments with respect to claims 1-3, 6-8, 9-11, and 14 have been fully considered but they are not persuasive.

With respect to claims 1-3 and 6-8, it is agreed that Grenier does not teach using a preservative heat treatment to a basic wood material. However, Grenier teaches forming a wood structure with pieces of wood that have already been removed of any deformities (column 3, lines 30-38). Furthermore, the admitted prior art clearly teaches using a thermal preservation process of a less durable or basic wood material comprising defects, to produce a durable wood material (Applicant's specification – page 1, lines 11-15). Thus, the combined teachings of Grenier and the admitted prior art disclose all limitations of the present invention.

With respect to claims 9-11 and 14, the claims are directed to a product, thus, in this case, if the end product of the invention and the product of the prior art are substantially identical in structure, the rejection made above in view of Grenier is valid.

"The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to

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be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972) (see MPEP § 2113).

The rejections of all pending claims are maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

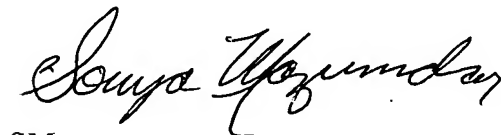
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SM



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